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By: _____

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:	Examiner: GARG, YOGESH C
BAUM	Art Unit: 3625
Application No.: 10/038,004	
Filed: 1/2/2002	
For: DISTRIBUTING IMAGES TO MULTIPLE RECIPIENTS	REQUEST FOR REINSTATEMENT OF APPEAL AND APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sirs:

Please revoke all previous power of attorney, and change the correspondence address to:

Xin Wen, 2800 Bridge Parkway, Redwood City, CA 94065.

A newly executed Power of Attorney form is attached.

In response to the Notification of Non-Compliant Appeal Brief mailed 05/22/2006, appellant has separately responded to the rejection to each independent claim. The subject title "SUMMARY OF INVENTIONS" is also corrected to "SUMMARY OF THE CLAIMED SUBJECT MATTER". Appellant resubmits Request for Reinstatement of the Appeal and offers this Appeal Brief in furtherance of the Office Action mailed on August 12, 2005 in the above-referenced patent application. Appendix A, attached hereto, contains a copy of all claims pending in this case.

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REAL PARTY IN INTEREST

All right, title, and interest in the subject invention and application are assigned to Shutterfly, Inc., having offices at 2800 Bridge Parkway, Suite 101, Redwood City, CA 94065. Therefore, Shutterfly, Inc. is the real party interest.

RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known which will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF THE CLAIMS

Claims 1-21 are present in the application. Claims 1, 14, 16, 17 and 21 were amended in an RCE preliminary amendment in response to Comments made in the Examiner's Answer mailed 8/26/03 for the First Appeal Brief filed on July 1, 2003. Claims 1-21 have been rejected and are the subjects of this appeal. No other claims are pending.

STATUS OF AMENDMENTS

A Final Office Action was mailed on 6/17/04. No amendment has been filed in response to the Final Office Action. An After Final Response was submitted on 7/13/04. An Advisory Action was mailed 8/10/04 noting that the Terminal Disclaimer was not acceptable. A substitute Terminal Disclaimer and Notice of Appeal were filed on 8/31/04. A copy of all the pending claims is provided in Appendix A, attached hereto.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention is related generally to distributing images, for example, digital and/or physical copies of images, to multiple recipients.

In accordance one aspect of the invention, one way to place an order is by having the user view previously uploaded images online, for example, with a browser and selectively designate which images should be printed. The user also will specify one or more recipients to whom prints should be distributed and, further, print parameters for each of the individual recipients, for example, not only parameters such as the size, number of copies and print finish, but potentially also custom messages to be printed on

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the back or front of a print. Application at page 19, lines 3-10. After the recipients and respective parameters have been specified, the user's order is fulfilled by making prints of the designated images and distributing them to the specified recipients (step 406). Application at page 19, lines 15-18.

Fig. 5 shows an exemplary graphical user interface (GUI) based environment that employs iconographic aliases (graphical representations of distribution groups) and graphical input techniques to enable a user to designate intended recipients of digital images and/or prints of the digital images. In the example shown in Fig. 5, the user, Jane Smith, has accessed her most recently uploaded images by entering into the browser's Address field 520 a uniform resource locator (URL) address 521 provided to her by the photo-finisher and corresponding to a web page at which her most recent images are hosted. In response, the browser window 501 accesses the specified address and displays its contents, namely, a greeting message 522, twelve images 508-519 recently uploaded by Jane, a link 523 to an archive that includes all of Jane's uploaded images, photo albums 524-526 representing collections of related images as grouped by Jane, and a picture delivery bar 500. Application, page 20, lines 5-15.

The picture delivery bar 500 includes one or more iconographic distribution aliases 502-507, each of which represents a distribution group of one or more recipients. The recipients specified in a distribution group may or may not have overlapping members in common with other distribution groups. For example, a member of the user's Friends distribution alias 504 may include one or more recipients who also are members of that user's Basketball Team distribution alias 506 or Co-workers distribution alias 505. In general, no limitations exist on the number or identities of members in a particular distribution alias. Application, page 20, lines 16-23.

As shown above, ease of use is provided to the user who orders a plurality of cards for different recipients. The cards may or may not be customized (for example, customized border or customized cropping, among others). This capability is useful during the winter holiday season, for example, to allow users to order 50 to 100 Christmas cards online for their family members and friends, who may be residing at different locations. Running through an order process one at a time for each of the 50-100

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Christmas cards is time consuming. This inconvenience in prior art ordering systems **JUN 0 6 2006** would deter many users from using the customized features for online card ordering.

ISSUES

I.   Whether claims 1-10, and 13-21 are anticipated by Lockhart (Application Serial No. 2002/0103697) under 35 U.S.C. § 102(e).

II.   Whether claims 11-12 are unpatentable over Lockhart and Harman. (USPN 5,960,411) under 35 U.S.C. § 103(a).

ARGUMENT

I.   CLAIMS 1-10, AND 13-21 ARE NOT ANTICIPATED BY LOCKHART

Claims 1-10, and 13-21 were rejected as anticipated by Lockhart (Application Serial No. 2002/0103697) under 35 U.S.C. § 102(e).

REJECTION OF CLAIMS 1-10, 13

Regarding claim 1, the Office Action asserted that Lockhardt shows a computer-implemented method of distributing cards to a plurality of recipients as follows:

> Receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence (see at least page 2, paragraphs 0021=0023, teach specifying contents to be included in a card [such as postcard, folding-out card, or the like-which can include greetings cards, as suggested in paragraphs 6 and 11] for a recipient. The contents to be included in the card include images which, one or more, are directly uploaded by a user associated with that recipient [see paragraphs 0050-0062]. Lockhardt also teaches that the order received specifying the contents for the said card can be addressed to a plurality of recipients [see at least paragraph 0086 "....and from which the user may select one or more desired addresses" (step 220...)) and paragraph 0088, "...For example, a single card design may be used for a variety of recipients...]. Selection of one or more addresses corresponds to a plurality of recipients. Lockhardt also teaches completing this single card order in a single transaction [see paragraph 0095 which teaches that after selecting recipient address [or addresses, as indicated above] the user's account, if it has a positive balance, is debited in a single transaction sequence.);

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for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set (see at least paragraph 0100); and

distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients (see at least paragraph 0100 which discloses that after printing the cards they are mailed to their respective recipient addresses).

Lockhart relates to a method for generating and distributing mail items that includes creating a first and a second mail file, wherein each of the first and second mail files includes recipient address information, and wherein the first mail file is generated by a first user, and the second mail file is generated by a second user. The first and second mail files are then transmitted to a mail service computer over a global computer network and printed, on a single sheet of media, a first mail item in accordance with the first mail file, and a second mail item in accordance with the second mail file. The first and second mail items are then placed into a surface mail system. The first mail item is addressed in accordance with the first recipient address information, and the second mail item is addressed in accordance with the second recipient address information. The mail item is then placed into the surface mail system in such a way as to minimize handling damage, and to leverage available postal technology. The mail items are then delivered to the postal addresses of the intended recipients.

Applicants respectfully traverse the Section 102 rejection. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). Here, Lockhardt fails to show a number of claimed elements and thus cannot anticipate claim 1.

Turning now to the rejection, paragraph 86 teaches that the user selects the address of the desired recipient 130 (steps 216-220). This is preferably accomplished using an address book scheme, wherein the user is presented with an address book (step 216), which may be augmented or otherwise modified (step 218), and from which the user may select one or more desired addresses (step 220). While paragraph 86 shows an address book, the paragraph is simply silent on the claimed single card order specifying a plurality of recipients.

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Similarly, paragraph 88 states that "a single card design may be used for a variety of recipients, wherein the first name of the recipient is imported from a merge data file (residing, for example, on the user's system, the mail service computer 110, or any other convenient location) and incorporated into the final mail item's text note." Paragraph 88 simply indicates that the user can share a single design with plurality of recipients using mail-merge. However, this does not show the claimed single card order specifying a plurality of recipients.

Additionally, nowhere in Paragraph 88 does it show a "card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence."

This understanding is further buttressed by paragraph 95 which notes that, for each recipient, the user's balance is accessed by the system. This is done *in seriatim* as follows:

> [0095] In step 206, after the recipient address for the mail item is selected, the user's account balance is accessed by the system. Such data might reside at mail service computer 110 or any convenient server. If the account balance is positive, the balance is decremented in accordance with the postage required for the mail item being sent (step 226). If the account balance is zero, or less than the required postage, then the user is provided the opportunity to purchase postcards or other mail items on-line. Depending upon the particular embodiment, the user may be able to purchase an arbitrary amount of postcards. Or the user may be presented with a choice of discrete quantities (1, 10, 25, etc.). In any event, the user is then prompted for suitable charge or debit card information, after which the user can confirm the purchase. The charge or debit is preferably authorized in conjunction with the appropriate credit authorization system 116 (for example, Visa, Mastercard, etc.).

Figure 2 in Lockhardt clearly shows before a new card is considered in step 230, the previously card has been purchased (step 206), entered all the content (steps 208-218), address (step 220), reviewed and scheduled (step 224), postage charged (step 226), and sent (step 228). The order for the previous card has been completed before the user starts the design of a new card.

In sum, the Office Action is reading more into the disclosure than what is taught by Lockhardt which suggests is mail merge can be done. Here, Lockhart shows two

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separate "orders" by first and second users that are then merged into a package for mailing. The element of "receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence" in claim 1 is missing in Lockhart. Lockhart does not show receiving a single card order specifying recipients that is completed in a single transaction sequence.

In sum, since one or more elements are missing and the elements are not arranged as required in claim 1, Applicants submit that Lockhardt cannot anticipate claim 1 as well as claims 2-9 and 13 that depend therefrom. Withdrawal of the rejection on claims 1-10 and 13 is requested.

REJECTION OF CLAIMS 14 AND 15

Regarding claim 14, the Office Action asserted that Lockhardt shows a computer-implemented method of distributing cards to a plurality of recipients as follows:

> Receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence (see at least page 2, paragraphs 0021=0023, teach specifying contents to be included in a card [such as postcard, folding-out card, or the like-which can include greetings cards, as suggested in paragraphs 6 and 11] for a recipient. The contents to be included in the card include images which, one or more, are directly uploaded by a user associated with that recipient [see paragraphs 0050-0062]. Lockhardt also teaches that the order received specifying the contents for the said card can be addressed to a plurality of recipients [see at least paragraph 0086 "....and from which the user may select one or more desired addresses" (step 220...)) and paragraph 0088, "...For example, a single card design may be used for a variety of recipients...]. Selection of one or more addresses corresponds to a plurality of recipients. Lockhardt also teaches completing this single card order in a single transaction [see paragraph 0095 which teaches that after selecting recipient address [or addresses, as indicated above] the user's account, if it has a positive balance, is debited in a single transaction sequence.);

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for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set (see at least paragraph 0100); and

distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients (see at least paragraph 0100 which discloses that after printing the cards they are mailed to their respective recipient addresses).

Lockhart relates to a method for generating and distributing mail items that includes creating a first and a second mail file, wherein each of the first and second mail files includes recipient address information, and wherein the first mail file is generated by a first user, and the second mail file is generated by a second user. The first and second mail files are then transmitted to a mail service computer over a global computer network and printed, on a single sheet of media, a first mail item in accordance with the first mail file, and a second mail item in accordance with the second mail file. The first and second mail items are then placed into a surface mail system. The first mail item is addressed in accordance with the first recipient address information, and the second mail item is addressed in accordance with the second recipient address information. The mail item is then placed into the surface mail system in such a way as to minimize handling damage, and to leverage available postal technology. The mail items are then delivered to the postal addresses of the intended recipients.

Applicants respectfully traverse the Section 102 rejection. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). Here, Lockhardt fails to show a number of claimed elements and thus cannot anticipate claim 14.

Turning now to the rejection, paragraph 86 teaches that the user selects the address of the desired recipient 130 (steps 216-220). This is preferably accomplished using an address book scheme, wherein the user is presented with an address book (step 216), which may be augmented or otherwise modified (step 218), and from which the user may select one or more desired addresses (step 220). While paragraph 86 shows an address book, the paragraph is simply silent on the claimed single card order specifying a plurality of recipients.

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Similarly, paragraph 88 states that "a single card design may be used for a variety of recipients, wherein the first name of the recipient is imported from a merge data file (residing, for example, on the user's system, the mail service computer 110, or any other convenient location) and incorporated into the final mail item's text note." Paragraph 88 simply indicates that the user can share a single design with plurality of recipients using mail-merge. However, this does not show the claimed single card order specifying a plurality of recipients.

Additionally, nowhere in Paragraph 88 does it show a "card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence."

This understanding is further buttressed by paragraph 95 which notes that, for each recipient, the user's balance is accessed by the system. This is done *in seriatim* as follows:

> [0095] In step 206, after the recipient address for the mail item is selected, the user's account balance is accessed by the system. Such data might reside at mail service computer 110 or any convenient server. If the account balance is positive, the balance is decremented in accordance with the postage required for the mail item being sent (step 226). If the account balance is zero, or less than the required postage, then the user is provided the opportunity to purchase postcards or other mail items on-line. Depending upon the particular embodiment, the user may be able to purchase an arbitrary amount of postcards. Or the user may be presented with a choice of discrete quantities (1, 10, 25, etc.). In any event, the user is then prompted for suitable charge or debit card information, after which the user can confirm the purchase. The charge or debit is preferably authorized in conjunction with the appropriate credit authorization system 116 (for example, Visa, Mastercard, etc.).

Figure 2 in Lockhardt clearly shows before a new card is considered in step 230, the previously card has been purchased (step 206), entered all the content (steps 208-218), address (step 220), reviewed and scheduled (step 224), postage charged (step 226), and sent (step 228). The order for the previous card has been completed before the user starts the design of a new card.

In sum, the Office Action is reading more into the disclosure than what is taught by Lockhardt which suggests is mail merge can be done. Here, Lockhart shows two

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separate "orders" by first and second users that are then merged into a package for mailing. The element of "a front-end computer sub-system for receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient, such images being directly uploaded by a user to the front-end computer sub-system, wherein the single card order is completed in a single transaction sequence" in claim 14 is missing in Lockhart. Lockhart does not show receiving a single card order specifying recipients that is completed in a single transaction sequence.

In sum, since one or more elements are missing and the elements are not arranged as required in claim 14, Applicants submit that Lockhardt cannot anticipate claim 14 as well as claim 15 that depends therefrom. Withdrawal of the rejection on claims 14 and 15 is requested.

REJECTION OF CLAIM 16

Regarding claim 16, the Office Action asserted that Lockhardt shows a computer-implemented method of distributing cards to a plurality of recipients as follows:

> Receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence (see at least page 2, paragraphs 0021=0023, teach specifying contents to be included in a card [such as postcard, folding-out card, or the like-which can include greetings cards, as suggested in paragraphs 6 and 11] for a recipient. The contents to be included in the card include images which, one or more, are directly uploaded by a user associated with that recipient [see paragraphs 0050-0062]. Lockhardt also teaches that the order received specifying the contents for the said card can be addressed to a plurality of recipients [see at least paragraph 0086 "....and from which the user may select one or more desired addresses" (step 220...)) and paragraph 0088, "...For example, a single card design may be used for a variety of recipients...]. Selection of one or more addresses corresponds to a plurality of recipients. Lockhardt also teaches completing this single card order in a single transaction [see paragraph 0095 which teaches that after selecting recipient address [or addresses, as indicated above] the user's account, if it has a positive balance, is debited in a single transaction sequence.);

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for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set (see at least paragraph 0100); and

distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients (see at least paragraph 0100 which discloses that after printing the cards they are mailed to their respective recipient addresses).

Lockhart relates to a method for generating and distributing mail items that includes creating a first and a second mail file, wherein each of the first and second mail files includes recipient address information, and wherein the first mail file is generated by a first user, and the second mail file is generated by a second user. The first and second mail files are then transmitted to a mail service computer over a global computer network and printed, on a single sheet of media, a first mail item in accordance with the first mail file, and a second mail item in accordance with the second mail file. The first and second mail items are then placed into a surface mail system. The first mail item is addressed in accordance with the first recipient address information, and the second mail item is addressed in accordance with the second recipient address information. The mail item is then placed into the surface mail system in such a way as to minimize handling damage, and to leverage available postal technology. The mail items are then delivered to the postal addresses of the intended recipients.

Applicants respectfully traverse the Section 102 rejection. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). Here, Lockhardt fails to show a number of claimed elements and thus cannot anticipate claim 16.

Turning now to the rejection, paragraph 86 teaches that the user selects the address of the desired recipient 130 (steps 216-220). This is preferably accomplished using an address book scheme, wherein the user is presented with an address book (step 216), which may be augmented or otherwise modified (step 218), and from which the user may select one or more desired addresses (step 220). While paragraph 86 shows an address book, the paragraph is simply silent on the claimed single card order specifying a plurality of recipients.

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Similarly, paragraph 88 states that "a single card design may be used for a variety of recipients, wherein the first name of the recipient is imported from a merge data file (residing, for example, on the user's system, the mail service computer 110, or any other convenient location) and incorporated into the final mail item's text note." Paragraph 88 simply indicates that the user can share a single design with plurality of recipients using mail-merge. However, this does not show the claimed single card order specifying a plurality of recipients.

Additionally, nowhere in Paragraph 88 does it show a "card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence."

This understanding is further buttressed by paragraph 95 which notes that, for each recipient, the user's balance is accessed by the system. This is done *in seriatim* as follows:

> [0095] In step 206, after the recipient address for the mail item is selected, the user's account balance is accessed by the system. Such data might reside at mail service computer 110 or any convenient server. If the account balance is positive, the balance is decremented in accordance with the postage required for the mail item being sent (step 226). If the account balance is zero, or less than the required postage, then the user is provided the opportunity to purchase postcards or other mail items on-line. Depending upon the particular embodiment, the user may be able to purchase an arbitrary amount of postcards. Or the user may be presented with a choice of discrete quantities (1, 10, 25, etc.). In any event, the user is then prompted for suitable charge or debit card information, after which the user can confirm the purchase. The charge or debit is preferably authorized in conjunction with the appropriate credit authorization system 116 (for example, Visa, Mastercard, etc.).

Figure 2 in Lockhardt clearly shows before a new card is considered in step 230, the previously card has been purchased (step 206), entered all the content (steps 208-218), address (step 220), reviewed and scheduled (step 224), postage charged (step 226), and sent (step 228). The order for the previous card has been completed before the user starts the design of a new card.

In sum, the Office Action is reading more into the disclosure than what is taught by Lockhardt which suggests is mail merge can be done. Here, Lockhart shows two

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separate "orders" by first and second users that are then merged into a package for